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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/932,065 | 08/17/2001 | Terence Wallace | 11596/2 | 4996 |

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EXAMINER

PREVIL, DANIEL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2632

DATE MAILED: 11/05/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,065

Applicant(s)

WALLACE, TERENCE

Examiner

Daniel Previl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: delete "upon" in line 7 and substitute it by ---until---. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaRosa (US 5,402,104).

Regarding claim 1, LaRosa discloses a housing (briefcase) includes a signal processor (transponder logic 29), a circuit arrangement (fig. 1 and fig. 2) and a energy source (battery 64) (col. 2, lines 7-48); an attachment device where the attachment device attaches the housing to the object (attach to a key ring by key ring attachment ear 12, the transponder-pager 30 attach to a belt using attachment clip 44) (col. 2, lines 9-12); a remote (30) where the remote transmits and receives signal to and from the signal processor, (transponder-pager 30,

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transmission by transponder of query signal, reception by transponder of response signal) (col. 2, lines 11-26); an input arrangement wherein the input arrangement enables a user to input commands to the circuit arrangement and signal processor, where the commands set at least one operation mode for the security device (on and off and channel selections are inputs for commands for asset protection transponder 10) (fig. 1, col. 2, lines 26-51); and output arrangement where the output arrangement produces an output based on the input commands (transponder pager can sound an audible, speech synthesized, alarm that tells the user which of the assets is now out of range) (col. 1, lines 33-47).

Although, LaRosa discloses every feature of the claimed invention but fails to specify that the signals include at least one of digital and analog signals. Since, LaRosa discloses a transponder pager 30 (col. 2, line 11). It is well known in the art to convert signals to analog to digital or digital to analog in order to transmit or receive clearer signals or pictures. So, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify that the transponder pager 30 includes a digital and analog signal to transmit or receive clearer signals to protect accurately personal assets from being stolen or inadvertently left behind.

Regarding claim 2, LaRosa discloses setting operational parameters of the security device (10) (receiver 20 will only respond to this signal if the signal receives matches the frequency set the frequency control switch 16) (col. 2, lines 39-63) (determining an operation mode of the security device (10) (asset protection transponder may be set in two ways: audibly and visually) (col. 2, lines 47-68; col. 3, lines 11-7); detecting a triggering signal based on the operational parameters (this signal will only be detected if it is on the frequency automatically set by scanning logic circuit 52) (col. 2, lines 57-67); selecting an output response based on the operational parameters (alerted in two ways: audibly and visually) (col. 2, lines 60-68; col. 3, lines 1-7).

Although, LaRosa discloses every feature of the claimed invention but fails to specify the step of executing the output response for at least one of a predetermined period of time and upon receipt of stop output command from the user. Since, LaRosa discloses small lightweight batteries to be used with reasonably battery life because most of the time the power consuming transmitter portion of the asset portion transponders are turned off) (col. 3, lines 8-13). It is well known in the art to allow the user to deactivate the alarm to save energy. So, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the user to deactivate the alarm to save reasonably energy consuming by the asset transponder 10.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
5. Benvenuti (US 6,166,652) discloses a system and method for locating misplaced items.

Russo et al. (US 5,640,144) discloses an RF/ultrasonic separation distance alarm.

Mardirossian (US 5,796,338) discloses a system for preventing loss of cellular phone or the like.

Olah (US 5,396,218) discloses a portable security system using communication cards.

Hampson et al. (US 6,052,054) discloses a portable scoreboard system with motion sensing for providing theft prevention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Previl whose telephone number is 703 305-1028. The examiner can normally be reached on Monday-Thursday. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on 305-4717. The fax phone numbers for the

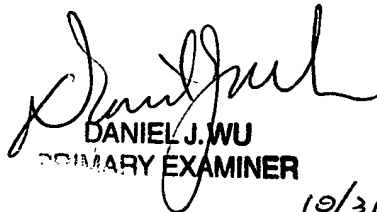
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organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-4700.

Daniel Previl
Examiner
Art Unit 2632

DP
October 8, 2002


DANIEL J. WU
PRIMARY EXAMINER
10/31/02